

REMARKS

This is intended as a full and complete response to the Final Office Action dated December 23, 2003, having a shortened statutory period for response set to expire on March 23, 2004. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-24 are pending in the application. Claims 1-24 remain pending following entry of this response, of which claims 10-22 are allowed. Claims 1, 2, 5 and 7 have been amended. Applicants submit that the amendments do not introduce new matter but merely re-state what Applicants believe was already claimed.

Applicant notes that claims 23 and 24, which are original claims, were apparently overlooked. Since claim 23 depends from claim 18, which is allowed, and since claim 24 depends from claim 23, Applicant submits that claims 23 and 24 are also allowed. Consideration of these claims is respectfully requested.

Claims 1, 2, 5 and 7 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Baisley* (US 6,502,112). Applicant respectfully traverses the rejection.

Baisley is directed to a method for comparing two XMI-based XML documents for identical content. The method begins with the step of parsing each of the documents to create a semantic graph of each documents' objects. (See, Abstract.) The Examiner suggests that the step of parsing the documents in *Baisley* is the same as invoking the specific data retrieval method in the present invention. The Applicant respectfully points out that the parsing performed in *Baisley* involves reading an XML document and creating a graph of its objects. (See Col. 4, lines 47-49.) This is done in *Baisley* so that in comparing two XML documents that are semantically identical, they are returned as equal, even if some semantically identical objects are located in different orders in the two documents. The tool in *Baisley* achieves this by parsing the documents, graphing their objects, sorting of the values of the objects that do not have a significant order, and comparing the resultant graphs. The specific data retrieval method of the present invention is invoked, however, only for those data lists in which data is not represented in a sortable format. In such cases, the specific data retrieval method transforms the data to a sortable format. *Baisley* makes no distinction regarding the sortability of data, but rather only makes a distinction about which data is to be sorted (i.e., the values of

the objects that do not have a significant order). Accordingly, *Baisley* does not teach, show or suggest invoking a specific data retrieval method on the basis of the sortability of data.

The Examiner further suggests that "the step of calling a generic data retrieval method if the data items are sortable in their default format is recited as a conditional step, and is thus not necessarily limiting the claim." The Applicant respectfully submits that this rejection is improper. While Applicant concedes that the Examiner may make the broadest reasonable interpretation of the claims, the Examiner may not read entire elements out of the claim. Any alleged anticipatory reference must necessarily disclose all claimed elements. The fact that a claim recites two reciprocal conditions (i.e., if $A=B$ and if $A \neq B$) in no way diminishes the fact two elements are in fact claimed. The satisfaction of any one of the two elements in a given instance of an implementation cannot serve to justify disregarding the other condition and corresponding effect. Applicant notes that satisfaction of a condition as a prerequisite for an occurrence is fundamental to algorithmic inventions and Applicant is unaware of any legal or procedural authority for the Examiner's position. Claim 1 provides a binary situation, i.e., a situation for having only two possibilities, either the data items are sortable in a default format or the data items are not sortable in the default format. The claim recites a particular result for each possibility, i.e., calling a generic data retrieval method or calling a specific data retrieval method. Thus, it is the conditional aspect of the claim itself that must be considered for purposes of patentability. Since both possibilities are recited and result in different steps, any reference cited to support a rejection for anticipation must disclose both possibilities and the corresponding steps. Therefore, the claims are believed to be allowable and allowance of the same is respectfully requested.

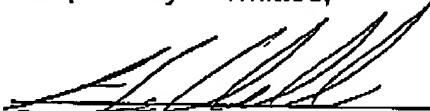
The foregoing notwithstanding, Applicant has amended claim 1 in effort to satisfy any concerns the Examiner may have regarding conditionality. Applicant submits that, as re-written, each element must be considered limiting of the invention. Reconsideration is respectfully requested.

Claims 3, 4, 6, 8 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the

limitations of the base claim and any intervening claims. Applicant acknowledges the allowable subject matter. However, claims 3, 4, 6, 8 and 9 have not been rewritten at this time because Applicant believes base claims of the allowable claims are allowable for the reasons stated above.

Having addressed all issues set out in the final office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



Gero G. McClellan
Registration No. 44,227
MOSER, PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Applicant(s)